



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,084	04/06/2005	Michael Ryan	Mo-7278US/MD-02	8710
23413 7590 04/14/2009 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER				
CORDRAY, DENNIS R				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
04/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/517,084

Applicant(s)

RYAN ET AL.

Examiner

DENNIS CORDRAY

Art Unit

1791

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,4-10,13-15,17,18 and 21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Dennis Cordray/
Examiner, Art Unit 1791

/Eric Hug/
Primary Examiner, Art Unit 1791

Continuation of 3. NOTE: The amended claims omit polyvinylamines thus require limitations not previously required, thus raising new issues that require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because: The arguments regarding the amendments to the claims are moot as the claims have not been entered.

Applicant argues that the debonders of Lindsay et al are not reacted strength reducing materials. A "reacted strength reducing material" is not defined in the instant Specification as requiring a chemical reaction as now argued. Absent a specific definition of the intended meaning, the claim is interpreted as a material that has in some manner reacted with the web components to reduce the strength of the web. Lindsay discloses that the debonder is applied to lower the dry strength, thus the debonder is in some manner reacted with the web components to affect the chemical or physical attributes thereof and reduce the strength of the web.

Applicant has also argued that insufficient reason has been given to substitute the temporary wet strength agents of Chen '679 or Orarian for the water soluble adhesives of Sheppard et al and Champaigne, Jr. et al. The fact that the materials disclosed in each of the references were known for the same use in the art presents strong evidence of obviousness in substituting one for the other as a functionally equivalent option. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

The water soluble adhesives of Sheppard et al and Champaigne, Jr. et al are for the purpose of dissolving or dispersing in water to allow the web to be dispersed in water and flushed (see abstracts of both references and col 2, lines 4-7 of Champaigne, Jr. et al). Sheppard et al further teaches that "The binder need not be completely water-soluble, but must be water dispersible, i.e., sufficiently water sensitive that after a short time immersion in water the binder loses its binding power thus permitting the web to disintegrate." (col 3, lines 64-68). Champaigne, Jr. et al further teaches that, "when the web is soaked in excess water and the water-soluble areas completely disprove in a short time, the web breaks apart ... into pieces, or patches, of postage stamp size which are easily flushed away." (col 3, lines 52-56). The adhesives thus serve as temporary wet strength agents.

The adhesives of Sheppard et al and Champaigne, Jr. et al are thus disclosed for the same purpose as the temporary wet strength agents of Chen et al '679 and Orarian et al. Absent convincing evidence of unobvious results due to the claimed polymers and commensurate in scope with the claims, it would have been obvious to one of ordinary skill in the art to substitute the temporary wet strength agents of Chen et al '679 and Orarian et al for the adhesives of Sheppard et al and Champaigne, Jr. et al and to have a reasonable expectation of success in obtaining a flushable product.

The outstanding rejections are maintained.